

From: Capobianco, Rochelle M.
Sent: Friday, February 22, 2013 11:36 AM
To: RCE outreach
Cc: Kerner, Shann; Capobianco, Rochelle M.
Subject: Written Comments Regarding RCE Practice

The following are my written comments regarding RCE practice.

- (1) *If within your practice you file a higher or lower number of RCEs for certain clients or areas of technology as compared to others, what factor(s) can you identify for the difference in filings?*

I file a high number of biotechnology RCEs.

- (2) *What change(s), if any, in Office procedure(s) or regulation(s) would reduce your need to file RCEs?*

Allowing multiple after-final amendments to be filed with supporting declarations would reduce my need to file RCEs. Some examiners allow this and some do not. Recently I spoke to an examiner and supervisory examiner in Group Art Unit 1641 who said they were unaware of the after-final program and when they did look into it, they said it was discretionary.

- (3) *What effect(s), if any, does the Office's interview practice have on your decision to file an RCE?*

I try to work it out with the examiner and supervisory examiner during the interview. If they are not receptive to my amendment or to me filing a declaration, then I have to file an RCE.

- (4) *If, on average, interviews with examiners lead you to file fewer RCEs, at what point during prosecution do interviews most regularly produce this effect?*

After a final rejection, I ask the examiner for an interview and then I send a draft response which will be discussed with the examiner and supervisory examiner during that interview.

- (5) *What actions could be taken by either the Office or applicants to reduce the need to file evidence (not including an IDS) after a final rejection?*

Sometimes the examiner is not very familiar with the subject matter being examined. For example, I had a case under examination by an examiner that did not know of the existence of antigen-binding fragments of antibodies. These have been known in the art for at least 20 years. If she had known this I would not have had to file evidence of this! However, it makes no sense to have an application refiled as an RCE to go to the bottom of the pile. The examiner finally understands the issues and has finally explained what

he/she requires to believe the argument we have provided. By waiting so long to get back to the case, the examiner is at Stage 1 again.

- (6) *When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of an RCE?*

I favor filing an RCE when the examiner will not accept a corroborating declaration with the response, and when he/she says a new search is required even after I show that the new search is not needed.

- (7) *When considering how to respond to a final rejection, what factor(s) cause you to favor the filing of an amendment after final (37 CFR 1.116)?*

If, during the interview, the examiners are receptive to a suggested amendment and will accept a corroborating declaration. Sometimes a few rounds with the examiner are needed to make he/she understand the difference between the prior art they have cited and the claimed subject matter.

- (8) *Was your after final practice impacted by the Office's change to the order of examination of RCEs in November 2009? If so, how?*

Not really, but now I always try to interview cases which have final rejections.

- (9) *How does client preference drive your decision to file an RCE or other response after final?*

The client wants the case examined as soon as possible, but if there is no way to get in a response and declaration except by filing an RCE, they want us to do it. I will go to a QAS to review the case sooner if time is of the essence.

- (10) *What strategy/strategies do you employ to avoid RCEs?*

Having interviews with supervisory examiners and examiners after sending a draft response after final for discussion; going to a QAS for review.

- (11) *Do you have other reasons for filing an RCE that you would like to share?*

No.

If you have any questions, please feel free to contact me.



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